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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,088	10/10/2001	Marie B. Connell-Porceddu	2411-110	4800

6449 7590 01/28/2003

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EXAMINER

BAUM, STUART F

ART UNIT	PAPER NUMBER
1638	9

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/973,088	CONNELL-PORCEDDU ET AL.
	Examiner Stuart F. Baum	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 November 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-9,11-43 and 45-81 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9,11-43 and 45-81 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5+7.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The amendment filed 11/15/02 has been entered.

Claims 1-9, 11-43, and 45-81 are pending.

Claims 10 and 44 have been canceled.

Claims 1-6, 9, 12, 15-16, 19-22, 25-39, 43, 46-47, 49, 52, 55, and 58-60 have been amended.

2. Rejections and objections not set forth below are withdrawn.

3. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

4. Claims 63-81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for the reasons of record set forth in the Official action mailed 5/22/2002. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has interpreted the Written Description rejection to be directed against their method of enhanced transformation and regeneration of transformed embryogenic pine. They believe the only way to describe the method is with words, structures, figures, diagrams and formulas. Applicants contend that because they are not claiming any DNA, a description of such is not required.

The Written Description rejection was not directed against the method of enhanced transformation and regeneration of transformed embryogenic pine, but against the transgenic embryogenic pine cultures and transformed pine plants. For a plant to be transformed, it must contain an exogenous or introduced piece of DNA that is not found in an untransformed plant.

Applicants have not described the genetics or phenotype of the transformed plants or embryogenic cultures that they are claiming and as such have not demonstrated that they are in possession of transformed embryogenic cultures or transformed pine plants.

5. Claims 1-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levee et al (1999, Molecular Breeding 5(5):429-440). This rejection is maintained for the reasons of record set forth in the Official action mailed 5/22/2002. Applicant's arguments have been fully considered but they are not persuasive.

Applicants contend that Levee et al does not disclose regeneration of stably transformed embryogenic cultures of pines of the *Pinus* subgenus. Applicant recites that the genus *Pinus* is divided into two groups, which translates into hard and soft wooded pines, that also exhibit differences in pathogen susceptibility. Applicants extrapolate this to mean that there is also a difference in *Agrobacterium* infection as well (page 12, first paragraph). Applicants contend that Levee et al teach transformation of *Pinus strobes* which is a soft wooded pine, as oppose to Applicant's claimed method which is directed towards a hard wooded pine. Applicant asserts that "somatic embryogenesis systems for soft pines are different from those for hard pines" (page 12, middle paragraph).

The Examiner contends that Applicants' mere unsupported assertions that hard pines are harder to transform than soft pines are not sufficient. Applicant asserted that there is a reason Levee et al chose *Pinus strobes* and not a hard wood pine because soft pines are easier to regenerate than hard pines (page 12, middle paragraph). Nowhere in the Levee et al reference do they mention the difference in regenerability of hard versus soft wood pines. Given the broad claim language as recited by Applicant and given the teachings of Levee et al, it would have been obvious to use the method of Levee et al and to optimize this method by optimization of process parameters that would not confer patentable distinction on the claimed invention, as stated in the previous office action.

6. No claims are allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

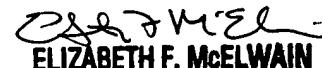
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 or (703) 305-3014 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, who may be contacted at 308-0196.

Stuart F. Baum Ph.D.  
January 22, 2003

  
ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1600